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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/538,130

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Ghislaine Tissot

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EXAMINER

KUBELIK, ANNE R

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

02/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/538,130

Applicant(s)

TISSOT ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 February 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Anne R. Kubelik/
Primary Examiner, Art Unit 1638

Continuation of 11, does NOT place the application in condition for allowance because:

102(e): Claims 1-3, 6-8, 13-15 anticipated by US 7,129,391:

Applicant urges that '391 only briefly describes general steps of transformation of soybean plastids and there is no disclosure of developed and fertile soybean plants; there is no guidance for regeneration of plants from the transformed plant material. This is not found persuasive because what is well-known in the art, soybean regeneration, need not be taught. Applicant urges that regeneration of fertile transplastomic leguminous plants was not routine at the time of the filing of '391. This is not found persuasive because it appears that Applicant used a method of regeneration of soybean after particle bombardment that was published in 1991 (specification pg 16, paragraph 1). Applicant does not appear to have done anything that was not routine in the art well before the 1998 filing of '391. Further, Applicant is not claiming any particular method of regeneration.

Applicant urges that Zhang says that it should be possible to transform soybean plastid if the methods are improved. This is not found persuasive because Zhang did not use the method used in '391.

Applicant urges that Bock states that fertile transplastomic plants have not been reported for any plant other than tobacco. This is not found persuasive because Bock does not state that the method of '391 does not work.

Applicant urges that Daniell 2005 attributes the first successful fertile transplastomic soybean plants to another. This is not found persuasive because Daniell 2005 does not state that '391 is not enabled. Daniell 2005 does not indicate, for example, if patent art was considered, or if only references in journal articles was the only art considered in making this statement.

Applicant urges that this situation is similar to Plant Genetics Systems and later developed technology cannot be relied upon to enable a patent. This is not found persuasive because there is no objective evidence that '391 is not enabled, or that bombarded soybean cells or callus could not regenerate into plants.

Applicant urges that '391 does not anticipate the vectors of claims 7-8 and 13; homologs sequences should not be interpreted to contain as few as two nucleotides because they must be of sufficient length to allow integration of the expression cassette into the plastid genome; '391 used tobacco sequences. This is not found persuasive because there is no evidence that the tobacco sequences did not allow integration of the expression cassette into the plastid genome.

Applicant urges that the methods of claims 14 and 15 are not anticipated because '391 did not result in fertile transplastomic soybean plants. This is not found persuasive for the reasons indicated above.

103: Claims 1-16 obvious over US 5,877,402 in view of von Allmen:

Applicant urges that the rejection relies on Zhang. This is not found persuasive because it does not. Zhang was discussed because Applicant argued it. The rejection stands without Zhang; however, Zhang indicates that it would be possible to do.

Applicant urges that Maliga indicates that tissue culture and regeneration is the limiting step. This is not found persuasive because it appears that Applicant used a method of regeneration of soybean after particle bombardment that was published in 1991 (specification pg 16, paragraph 1). Applicant does not appear to have done anything with respect to soybean regeneration that was not routine in the art well before the filing of the instant application. Further, Applicant is not claiming any particular method of regeneration.

Applicant urges that cites '391, Bock, Zhang Dufourmantel and Daniell 2005 to states that methods for regenerating fertile transplastomic soybean plants were unknown prior to the instant filing; thus, there was no reasonable expectation of success. This is not found persuasive. Applicant appear to be arguing that their method of regeneration is critical to their success. However, this limitation is not claimed. Further, there is indication in Dufourmantel or the instant specification that the method of regeneration is critical. Applicant has not shown why it would not be obvious to replace the tobacco flanking regions with the corresponding ones from soybean plastids